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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,794	04/27/2000	Jeffrey T. Palumbo	49464-(849)	2665

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EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/559794

Applicant(s)

Palumbo et al.

Examiner

Short

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- ☒ Responsive to communication(s) filed on July 3, 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-13, 17-23, 27-29, 34-47, 50-55, 59-63 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13, 17-23, 27-29, 34-47, 50-55, 59-63 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

**Application Papers**

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13, 17-23, 27-29, 34-47, 50-55 and 59-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is applied as in the previous Office action. Applicant argues that one of ordinary skill in the art would understand that the term "low polarity oligomeric block" or "low polarity polymeric block" applies to oligomeric blocks or polymeric blocks having a surface tension of lower than about 35 dynes/cm and cites *Coatings Encyclopedia Dictionary* to support this statement. However, no copy of the relevant portions of the cited reference was provided. Upon the submission of a copy of the relevant portions of the cited reference, applicant's argument will be reconsidered. With respect to the term "substantial adhesion", this term does not appear to be defined in the specification and thus, it is not clear what constitutes substantial adhesion for purposes of the claimed invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-12, 17-22, 35-47, 50-54 and 60-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lin. The rejection is applied as in the previous Office action. Applicant argues that the reference does not suggest copolyesters having a low polarity block incorporated into the chain, specifically a low polarity block in which the low polarity block is a telechelic polyolefin, telechelic fluoropolymer or an ABA block structure. The claims are not limited to copolyesters having a low polarity block in which the low polarity block is a telechelic polyolefin, telechelic fluoropolymer or an ABA block structure. Where the *claimed* product/method and prior art product/method are substantially the same, the burden is upon applicant to show that the prior art product/method does not inherently possess the characteristics of the claimed invention. See *In re Best* 195 USPQ 430 (CCPA 1977); *In re Tomlinson* 150 USPQ 623 (CCPA 1966).

Claims 1-13, 17, 20-22, 37-47, 50-53 and 60-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Policastro. The rejection is applied as in the previous Office action. Applicant argues that the reference does not suggest copolyesters having a low polarity block incorporated into the chain, specifically a low polarity block in which the low polarity block is a telechelic polyolefin, telechelic fluoropolymer or an ABA block structure. The claims are not limited to copolyesters having a low polarity block in which the low polarity block is a telechelic polyolefin, telechelic fluoropolymer or a telechelic ABA block structure. Where the *claimed* product/method and prior art product/method are substantially the same, the burden is upon applicant to show that the prior art product/method does not inherently possess the characteristics of the claimed invention. See *In re Best* and *In re Tomlinson* cited above.

Claims 1-13, 17-23, 37-47, 50-53, 55 and 60-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peters '158. The

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rejection is applied as in the previous Office action. Applicant argues that the reference does not suggest using a low molecular weight telechelic polyolefin such as polyolefins having a weight average molecular weight of between 500 and 4500. The claims are not limited to copolyesters having a low polarity block in which the low polarity block is a low molecular weight telechelic polyolefin having a weight average molecular weight of between 500 and 4500. Where the *claimed* product/method and prior art product/method are substantially the same, the burden is upon applicant to show that the prior art product/method does not inherently possess the characteristics of the claimed invention. See *In re Best* and *In re Tomlinson* cited above.

Claims 37-47, 50-54 and 62 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious each of Hallgren and Eichenauer. The rejections are applied as in the previous Office action. Applicant argues that the references do not suggest copolyesters having a low polarity ABA block incorporated into the chain and do not suggest that such block copolymers have superior adhesion. The claims are not limited to copolyesters having a low polarity block in which the low polarity block has ABA block structure. Where the *claimed* product/method and prior art product/method are substantially the same, the burden is upon applicant to show that the prior art product/method does not inherently possess the characteristics of the claimed invention. See *In re Best* and *In re Tomlinson* cited above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

P. Short

September 11, 2002

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